The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte CLAY T. WHITEHEAD

Appeal 2007-0988
Application 09/863,010[1]
Technology Center 3600

Decided: March 27, 2007

Before HUBERT C. LORIN, JENNIFER D. BAHR, and STUART S. LEVY, *Administrative Patent Judges*.

LORIN, *Administrative Patent Judge*.

DECISION ON APPEAL

[1]Filed 23 May 2001.

STATEMENT OF THE CASE

The appeal is from a decision of the Examiner rejecting claims 1-5, 7-9, 12, 14-16 and 18-22[2] over the prior art. 35 U.S.C. § 134 (2002). We have jurisdiction under 35 U.S.C. § 6(b) (2002).

We AFFIRM.

Appellant's Brief, filed 3 January 2006, focuses principally on claim 1, with passing references to claims 14, 21, and 22. Claims 3, 4, and 15 are briefly mentioned. Pursuant to the rules, the Board selects representative claim 1 to decide the appeal. 37 C.F.R. § 41.37(c)(1)(vii) (2006). However, we will also address claims 3, 4, 14, 15, 21, and 22 to the extent they have been argued.

Claims 1, 3, 4, 14, 15, 21, and 22 read as follows:

> 1. A method of administering consumer items over a global network, the method comprising:
> (a) compiling a user profile relating to desired consumer items;
> (b) accessing a database of items available from product and service providers, and identifying relevant items according to the user profile;
> (c) if the user profile incorporates an automatic best choice service, automatically implementing the relevant items, and communicating the implemented relevant items to the user;
> and
> (d) if the user profile does not incorporate the automatic best choice service, communicating the relevant items to the user, and enabling the user to selectively implement the relevant items.
>
> 3. A method according to claim 2, wherein step (a) is further practiced according to user-entered parameters.
>
> 4. A method according to claim 1, further comprising periodically repeating steps (b)-(d).

[2] Appellant states that claims 6, 10, 11, 13, and 17 have been withdrawn from consideration. Br. 5.

14. A method of obtaining and maintaining consumer items including products and services at a lowest available cost over a global network, the method comprising:

(a) compiling a user profile according to a pattern of customer use and user-entered parameters;

(b) maintaining a database of items available from product and service providers;

(c) accessing the database of items and identifying relevant items according to the user profile;

(d) if the user profile incorporates an automatic best choice service, automatically implementing the relevant items, and communicating the implemented relevant items to the user;
and

(e) if the user profile does not incorporate an automatic best choice service, communicating the relevant items to the user, and enabling the user to selectively implement the relevant items.

15. A method according to claim 14, further comprising periodically repeating steps (b)-(e).

21. A computer system for administering consumer items, the computer system comprising:

at least one user computer running a computer program that compiles a user profile relating to desired consumer items and accesses a database of items available from product and service providers, the computer program identifying relevant items according to the user profile; and

a system server running a server program, the at least one user computer and the system server being interconnected by a computer network, the system server maintaining at least a portion of the database of available items and effecting implementing of the relevant items according to user preferences,

wherein if the user profile incorporates an automatic best choice service, the computer program automatically implementing the relevant items, and communicating the implemented relevant items to the user, and

wherein if the user profile does not incorporate the automatic best choice service, the computer program communicating the relevant items to the user, and enabling the user to selectively implement the relevant items.

22. A computer program embodied on a computer-readable medium for administering consumer items, the computer program comprising:

means for compiling a user profile relating to desired consumer items,

means for accessing a database of items available from product and service providers, and for identifying relevant items according to the user profile;

if the user profile incorporates an automatic best choice service, means for automatically implementing the relevant items, and for communicating the implemented relevant items to the user; and

if the user profile does not incorporate the automatic best choice service, means for communicating the relevant items to the user, and for enabling the user to selectively implement the relevant items.

ISSUES

Has Appellant shown that the Examiner did not give the claims their broadest reasonable construction in light of the Specification as it would be interpreted by one of ordinary skill in the art and in so doing erred in concluding that the prior art anticipates the claimed invention?

FINDINGS OF FACT - BACKGROUND

The following findings of fact (FF) are believed to be supported by at least a preponderance of the evidence.

1. The Examiner finally rejected claims 1-5, 7-9, 12, 14-16 and 18-22 as being unpatentable under 35 U.S.C. § 102(e) over Herz (see Answer 5, mailed 21 March 2006).
2. US 2001/0014868 A1 ("Herz") published on 16 August 2001.
3. The Examiner provides a limitation-by-limitation analysis of each claim showing where in Herz the claimed invention is described. Answer 5-7.
4. The Examiner finds that Herz describes step (a) of claim 1 at paragraph 002:

> The system automatically constructs and updates profiles of a plurality of shoppers based on their demographics and their history of shopping behavior, which history includes both their purchases and their requests for, or reactions to, product information.

Answer 5.

5. The Examiner finds that Herz describes step (b) of claim 1 at paragraph 0024:

> The primary functions of the system for the automatic determination of customized prices and promotions 100 are (a) to identify offers that are appropriate for each shopper, (2) to help the shopper become informed about these available offers, and (3) to facilitate any or all of the necessary transactions, such as electronic ordering or payment, if the shopper decides to accept an offer. The present system for the automatic determination of customized prices and promotions 100 concerns functions (1) and (2). In order to carry these functions out, the main computer 101 has access to databases of information about possible offers (offer database 122)

Answer 5.

6. The Examiner finds Herz describes step (c) of claim 1 at paragraph 004:

> "The system automatically constructs product offers tailored to individual shoppers, or types of shoppers, in a way that attempts to maximize the vendor's profits. These offers are typically represented to the shoppers in digital form. They are communicated... or to an on-line computer shopping system that directly makes such offers to shoppers. The shoppers can be in the market for any type of product or service, including but not limited to: retail products, financial services, professional services, and the like."

And paragraph 024:

> The primary functions of the system for the automatic determination of customized prices and promotions 100 are (1) to

> identify offers that are appropriate for each shopper, (2) to help the shopper become informed about these available offers, and (3) to facilitate any or all of the necessary transactions, such as electronic ordering or payment, if the shopper decides to accept an offer. ... In order to carry these functions out, the main computer 101 has access to databases of information about possible offers (offer database 122)

Answer 5-6.

7. The Examiner further states that "[i]nforming the shopper automatically of the best offers based upon his profile and the offers stored in a database reads upon the recited limitation. If condition in (c) is satisfied then condition in (d) does not exist. See also paragraphs 0005, 0010, and 0246. Paragraph 0246 discloses that even if the offers database does not include the automatic best choice requirement for the user the system communicates a single best possible offer for [a good or service] for the user's selection...." Answer 6.

8. Appellant does not appear to dispute the Examiner's characterization of Herz.

9. Appellant's principal contention is that the instant invention differs from Herz in that the instant method/system is user-driven rather than, as in Herz, seller-drive and that this is a distinction the Examiner did not appreciate and, accordingly, Herz does not anticipate the claimed invention.

10. Appellant's arguments are contained in seven paragraphs on pages 12 to 14 of the Brief .

11. The first paragraph states that "[a]n important distinction between the present invention and the Herz publication is that the present invention is

rather a buyer-driven system that seeks suitable products and services for a particular user based on a user profile."

12. The second paragraph states that

> [T]he claims define a method/system that utilizes a user profile relating to desired consumer items, and thus the administration is effected from a buyer's perspective. Moreover, if the automatic best choice service is incorporated in the user profile, the relevant items are automatically implemented. Since the Herz system is in contrast a seller-driven system, Herz could in no way incorporate an automatic best choice service. Applicant thus respectfully submits that Herz lacks at least step (c) of claim 1, step (d) of claim 14, and related subject matter defined in claims 21 and 22.

13. The third paragraph states that "[a]s recognized in the Office Action, at best, the Herz system identifies and makes offers suitable to particular shoppers. Nowhere does the Herz system even remotely appreciate a potential application where one or more of those offers is automatically accepted."

14. The fourth paragraph states:

> [I]ndependent claim 1 defines in step (c), "if the user profile incorporates an automatic best choice service, automatically implementing the relevant items, and communicating the implemented relevant items to the user." Emphasis added. A similar feature is included in independent claims 14, 21 and 22. As noted, the automatic best choice service of the invention is an important feature enabling the relevant items to be automatically implemented (i.e., the best offer(s) for that particular user is automatically accepted). In each instance in the Herz patent, in contrast, the shopper must make a decision to accept an offer. Additionally, a determination of a "best" offer will likely be different depending on from whose perspective, i.e., buyer or seller, it is viewed. Thus, the presentation of "best offers' in the Herz system may not even identify the offer that would be automatically accepted with the automatic best choice service defined in the present application claims.

15. The fifth paragraph states: "[f]or at least these reasons, Applicant thus respectfully submits that the rejection is misplaced."

16. The sixth paragraph on page 14 states:

> [C]laim 3 recites that step (a) is practiced according to user-entered parameters. The Office Action references the Herz system tracking the behavior of shoppers. Such tracking, which is the nature of a seller-driven system, does not in any manner meet the feature of the invention where a user profile is compiled according to user-entered parameters.

17. The seventh paragraph states:

> Claim 4 defines a step of periodically repeating steps (b)-(d). Claim 15 defines related subject matter. The Office Action references seasonal buying for certain groups of shoppers, which again is a parameter of a seller-driven system. In the present invention, periodically repeating the consumer item administration regularly ensures the user that he/she has implemented the best products and services according to their particular user profile.

18. The Examiner responds, in part, that

(a) "[s]tep C of claim 1 reads This is a conditional statement implying that the user profile may or may not incorporate a best choice and if the best choice is not there in the profile then step (c) ... is not relevant" (Answer 8-9);

(b) "it is noted that the features upon which applicant relies (i.e., his invention is not seller driven and that a seller driven system in no way can incorporate an automatic best choice service) are not recited in the rejected claim(s)" (Answer 9); and,

(c) "[n]one of these steps expressly recite a function involving an automatically accepting a best offer by the user" (Answer 10).

19. Appellant responds, in part, that:

(a) "the language [of claim 1, step (c)] requires that the user profile provide the user with an *option* [emphasis original] to incorporate the automatic best choice service. This is an important feature of the invention ... lacking in the Herz publication" (Reply Br. 1); and

(b) "[n]owhere does the Herz publication, however, even remotely appreciate an ability to accept an offer without user intervention (i.e., to automatically implement identified relevant items)" (Reply Br. 2); and

(c) "[c]laim 1, however, defines in step (c) the step of automatically implementing the relevant items if the user profile incorporates an automatic best choice service. The automatic implementation of the relevant items is indeed an express recitation of automatically accepting a best offer. The term "implement" in the claims is not used in a manner inconsistent with its ordinary meaning" (Reply Br. 3).

PRINCIPLES OF LAW

1. A claim is anticipated under 35 U.S.C. §102 "if each and every limitation is found either expressly or inherently in a single prior art reference." *Bristol-Myers Squibb Co. v. Ben Venue Labs, Inc.*, 246 F.3d 1368, 1374, 58 USPQ2d 1508, 1512 (Fed. Cir. 2001).

2. "The Patent and Trademark Office ("PTO") determines the scope of claims in patent applications not solely on the basis of the claim language, but upon giving claims their broadest reasonable construction 'in light of the specification as it would be interpreted by one of ordinary skill in the art.' *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364 [70 USPQ2d 1827, 1830] (Fed. Cir. 2004)." *Phillips v. AWH Corp.*, 415 F.3d 1303, 1316, 75 USPQ2d 1321, 1329 (Fed. Cir. 2005).

3. The goal of claim construction is "to interpret what the patentee meant by a particular term or phrase in a claim." *Renishaw PLC v. Marposs Societa' per Azioni*, 158 F.3d 1243, 1249, 48 USPQ2d 1117 (Fed Cir 1998).

4. In interpreting what appellant means by a particular term or phrase, the Board looks first at the claim.

> The claims of the patent provide the concise formal definition of the invention. They are the numbered paragraphs which "particularly [point] out and distinctly [claim] the subject matter which the applicant regards as his invention." 35 U.S.C. §112. It is to these wordings that one must look to determine whether there has been infringement. [Footnote omitted.] Courts can neither broaden nor narrow the claims to give the patentee something different than what he has set forth. [Footnote omitted.] No matter how great the temptations of fairness or policy making, courts do not rework claims. They only interpret them.

E.I. DuPont de Nemours & Co. v. Phillips Petroleum Co., 849 F.2d 1430, 1433, 7 USPQ2d 1129, 1131 (Fed Cir 1988).

5. "[I]t is always necessary to review the specification to determine whether the inventor has used any terms in a manner inconsistent with their ordinary meaning." *Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576, 1582, 39 USPQ2d 1573, 1576-77 (Fed Cir 1996).

6. "The problem is to interpret claims "in view of the specification" without unnecessarily importing limitations from the specification into the claims." *E-Pass Techs., Inc. v. 3Com Corp.*, 343 F.3d 1364, 1369, 67 USPQ2d 1947, 1950 (Fed. Cir. 2003).

ANALYSIS

We have carefully reviewed the record and find that Appellant has not shown that the Examiner erred in concluding that a prima facie case of anticipation is made by Herz for the subject matter of the claims.

We agree with the Examiner that Appellant's arguments are not commensurate in scope with the claims. "Many of appellant's arguments fail from the outset because, ... they are not based on limitations appearing in the claims" *In re Self*, 671 F.2d 1344, 1348, 213 USPQ 1, 5 (CCPA 1982).

Appellant has not disputed the Examiner's characterization of Herz. FF 8. The dispute is over whether the claimed method reads on that of Herz and more particularly over the scope to be given the claims. Appellant contends that the Examiner has misconstrued the claims, arguing that the claims describe a method that is different from that of Herz; that is, according to Appellant the claims describe a user-driven rather than a seller-driven method. FF 9, 11. For the following reasons, we are not persuaded that the claims have a scope as narrow as Appellant argues.

Appellant argues that the language of claim 1, step (c), requires the user profile to provide the user with an *option* to incorporate the automatic best choice service. FF 19(a). We disagree. Nowhere in the claim is there a provision requiring the user profile to include an *option* to incorporate the automatic best choice service. Steps (c) and (d) provide alternative actions for administering consumer items over a global network, i.e., "if the user profile incorporates an automatic best choice service" and "if the user profile does not incorporate the automatic best choice service." From a plain reading of the claim, as interpreted by one of ordinary skill in the art, the user profile may or may not incorporate an automatic best choice. To interpret the claim as requiring the user profile to include an option by which a user may choose to have his or her user profile

incorporate or not incorporate an automatic best choice service unnecessarily imports an *option* limitation into the claim.

Appellant argues that the claimed method allows for the ability to automatically accept an offer on behalf of the user without user intervention. FF 12-14 and 19(b) and (c). The claim nowhere limits the method to one involving *no* user intervention. The claim nowhere calls for the user to *accept* an offer, let alone a method which *automatically accepts* an offer. Appellant directs our attention to the phrase "automatic best choice service" in step (c). Even if we assume, arguendo, that the claimed method requires the user profile to include an option to incorporate an automatic best choice service, the broadest reasonable construction to be given the phrase consistent with the Specification as interpreted by one of ordinary skill in the art reading the claim as a whole is that it defines a service that automatically determines the best choice among consumer items offered on the global network. Appellant does not direct us to the Specification for a meaning inconsistent with this construction, nor can we find any. In fact, the Specification states, consistent with its plain meaning, that "the automatic best choice service [allows] relevant consumer items identified by the system according to the user profile [to be] automatically implemented" (Specification 9-10). The ordinary and customary meaning of "implemented" is "carried out."[3] The Specification does not give the term a meaning inconsistent with this ordinary and customary meaning and nowhere suggests it means "accepting" the best choice or accepting the best choice without user intervention. We disagree with Appellant that "[t]he automatic implementation of the relevant items is indeed an express recitation of

[3] *The Random House College Dictionary* 667 (1973).

automatically accepting a best offer" (FF 19(c)). Appellant has provided no evidence showing that one ordinary skill in the art would give that interpretation. Accordingly, to interpret the phrase as requiring automatically accepting the best choice without user intervention, as Appellant argues, unnecessarily imports a user-independent automatic accepting limitation into the "automatic best choice" phrase in the claim.

Appellant also argues that, in contradistinction to Herz, claim 3 calls for compiling a user profile related to desired consumer items through "user-entered" parameters. FF 16. However, Appellant has not disputed the Examiner's characterization of Herz (Answer 12) that it discloses tracking a shopper's purchases via computer terminals, which tracking is then used and stored as a shopper's profile. We find that Herz discloses (see paragraphs 0021-0024) what the Examiner has said it discloses. We find that "user-entered" parameters reads on Herz's disclosure of making purchases using computers and "compiling a user profile related to desired consumer items" reads on Herz's disclosure of tracking a shopper's purchases to form a profile of the shopper. Therefore Herz fully describes the method set forth in claim 3.

Lastly, Appellant argues that claim 4 (and related subject matter in claim 15) which calls for repeating steps (b)-(d) is not met by Herz's disclosure of seasonal buying because the claimed method is "user-driven" and not "seller-driven." FF 17. However, neither this claim nor independent claim 1 on which it depends makes any reference to "user-driven." Nowhere in these claims is there a provision limiting practice of the method to the user. For example, step (a) calls for "compiling a user profile." But who does the compiling is not stated. To agree with Appellant's argument would require us to read into the claim a limitation that only the user and not the seller compiles the user profile. Since doing so would

unnecessarily limit the scope of the claim, Appellant's argument is deemed unpersuasive as to error in the rejection.

All of Appellant's arguments have been addressed.

CONCLUSION OF LAW

On the record before us, the Examiner's evidence and rationale is sufficient to make out a prima facie case of obviousness under 35 U.S.C. § 102(e) for claims 1-5, 7-9, 12, 14-16 and 18-22. Appellant's arguments are not persuasive as to error in the prima facie case.

DECISION

The Examiner's rejection of claims 1-5, 7-9, 12, 14-16 and 18-22 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv) (2006).

AFFIRMED

hh

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